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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/596,784 06/19/00 BOGDANOVE

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EXAMINER

BUGAIISKY, G

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/596,784

Applicant(s)

Bogdanove et al.

Examiner
Gabriele E. Bugalsky

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1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 26, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 and 38-43 is/are pending in the application.
- 4a) Of the above, claim(s) 20-28 and 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19, 38, and 39 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Applicant's election with traverse of Group I (claims 17-19 and 38-39) in Paper No.7 is acknowledged. The traversal is on the ground(s) that the claims require common areas of search and consideration. This is not found persuasive because a) microbial proteins are classified in Class 530, subclass 350, with about 5400 patents and bioactive compositions thereof are classified in class 514, subclasses 2 and 12, with about 6228 patents; thus, more than 11,000 patents must be searched. Antibodies, on the other hand, are classified in at least class 530, subclasses 387.1 and 387.9, with about 1700 patents and bioactive compositions containing antibodies are classified in Class 424, subclasses 139.1 and 150.1, with about 300 patents; thus about 2000 additional patents must be searched relative to Group I. The required searches for each group are NOT co-extensive, and are not limited to U.S. patents; indeed, the large number of U.S. patents in each Group alone constitutes a burden on an Examiner. With respect to Groups II and III, at such time that the recited method claims read only upon allowed subject matter, they will be rejoined with Group I and considered on their merits.

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-28 and 40-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

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Information Disclosure Statement

The Examiner regrets that none of the references cited on the information disclosure statement (paper No. 3) could be found in the priority applications. The Examiner requests Applicants to submit new copies of non-US patent references for consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17, 19 and 38-39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated HR eliciting protein comprising SEQ ID NO:2 or 4 and compositions containing either protein, does not reasonably provide enablement for any isolated HR eliciting protein, wherein a nucleic acid encoding that protein hybridizes to nucleic acid encoding SEQ ID NO:2 or 4. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Applicants have provided two proteins encoded by an operon of *Erwinia amylovora*, but have defined no structural characteristics that would serve to identify other homologous proteins from any other species or genus, nor has the specification suggested the sources for other proteins that may be encompassed by the broadly recited claims.

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It is deemed that the specification is not sufficiently enabling to permit one of ordinary skill in the art an unambiguous isolation of any proteins other than the two specifically recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 19 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by He *et al.* The reference provides for Harpin_{PSS}, which is a HR elicitor. He *et al.* is deemed anticipatory for the claimed subject matter because under sufficiently non-stringent conditions, the DNA encoding Harpin_{PSS} would be expected to hybridize to DNA encoding the proteins of SEQ ID NO:2 or 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over He *et al.* The reference is discussed above; it does not provide for a composition containing Harpin_{PSS}. In order to control plant growth and control insects, it would have been obvious to one of ordinary skill in the art to add an insecticide to the protein composition of He *et al.*, with a reasonable expectation of success.

Conclusion

No claims are allowed.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

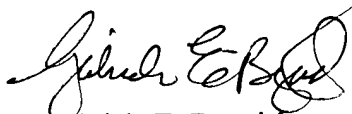
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201. The Examiner can normally be reached from 5:50 AM to 11:50 AM on Mondays and from 8:00 AM to 2:00 PM on other weekdays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher S. F. Low, can be reached at (703) 308-2923.

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Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.



Gabriele E. Bugaisky

Patent Examiner

June 4, 2001